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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,105	08/10/2006	Anders Jakobsson	40597	5367
116	7590	08/28/2007	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			NGUYEN, DUNG V	
		ART UNIT		PAPER NUMBER
		3723		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/581,105	JAKOBSSON ET AL.
	Examiner	Art Unit
	Dung V. Nguyen	3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11,16,17,20,21,23 and 26-29 is/are rejected.
- 7) Claim(s) 12-15,18,19,22,24 and 25 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 August 2006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/31/2006 & 6/22/2006</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 16, 17 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 16 recites the broad recitation not smaller than 35 degrees, and the claim also recites not smaller than 40 degrees, claim 21 recites the broad recitation 10-30 degrees, and the claim also recites 15-30 degrees which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over lida (USPN 6,546,631) in view of Donnerdal (USPN 6,591,826). lida discloses a portable working machine 10 comprising a tool unit with a disc guard 15, circular disc shaped tool 12 rotating about an axis 13, machine unit with filter system, an internal combustion engine 30, handles 23 and 24, control 22, tool carrier 60 uniting machine unit and tool unit arranged on the right side of the machine and having an endless driving belt 62, wherein the engine 30 is inclined forwards in a direction towards the tool unit to form a tilt angle large than zero (note Fig. 1, col. 2, line 50 to col. 3, line 28). However, lida does not disclose a muffler. Donnerdal discloses a portable working machine having a muffler 14 (note Fig. 1, col. 3, lines 14-29). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the machine of lida with a muffler disclosed by Donnerdal in order to reduce noise generated by the combustion engine.

6. Claims 2-7, 9-11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over lida (USPN 6,546,631) in view of Donnerdal (USPN 6,591,826). lida, modify by Donnerdal, does not disclose the tilt angle is 5-40, 5-30, 10-20, 7-40, 7-30 or 10-25 degrees. It would have been obvious to one having ordinary skill in the art at the

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time the invention was made to select a tilt angle of 5-40, 5-30, 10-20, 7-40, 7-30 or 10-25 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involved only routine skill in the art. *In re Aller*, 105 USPQ 233.

7. Claims 20, 23 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iida (USPN 6,546,631) in view of Donnerdal (USPN 6,591,826). Iida, modify by Donnerdal, does not expressly disclose a pear shaped muffler, a front bottom part of fuel tank protrudes forward under crankcase, an assembly positioned above a fuel tank, a spark plug located in front top part of machine. At the time the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to select a pear shaped muffler, a front bottom part of fuel tank protrudes forward under crankcase, an assembly positioned above a fuel tank, a spark plug located in front top part of machine because applicant has not disclosed that the above features provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected machine of Iida and applicant's invention, to perform equally well with machine taught by Iida or the applicant machine because both would perform the same function of cutting material. Therefore, it would have been *prima facie* obvious to modify Iida to obtain the invention as specified in claims 20, 23 and 27-29 because such modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Iida and Donnerdal.

Allowable Subject Matter

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8. Claims 12-15, 18, 19, 22, 24 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tubesing, Soderqvist et al, Taomo et al, Claesson and Terpstra are cited to show portable cutting machines.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung V. Nguyen whose telephone number is 571-272-4490. The examiner can normally be reached on IFP Program.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Dung Van Nguyen
Primary Examiner
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DVN
August 22, 2007